

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NORIKO MIZOBUCHI, YUICHI HASEGAWA,  
MITSUHIRO KAWADA and SHIN-ICHI HISAIKI

Appeal No. 2005-1098  
Application No. 09/242,700

HEARD: July 14, 2005

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before SCHEINER, ADAMS and MILLS, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 14, 16 and 23-25 which are all of the claims on appeal in this application. Claims 26 and 27 have been withdrawn from consideration by the Examiner.

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Claim 14 is representative of the claims on appeal reads as follows.

14. An ointment consisting of acetyl salicylic acid and a base selected from the group consisting of hydrocarbon gel, petrolatum and a mixture thereof without any other additive for said acetyl salicylic acid and wherein the ointment does not contain water for dissolving said acetyl salicylic acid,

wherein when the base is hydrocarbon gel or a mixture of hydrocarbon gel and petrolatum, the acetyl salicylic acid is in a range of 20 to 30% by weight per total weight, and wherein when the base is petrolatum, the acetyl salicylic acid is in a range of 25 to 30% by weight per total weight.

No prior art references are relied upon by the examiner.

#### Grounds of Rejection

Claims 14, 16 and 23-25 stand rejected under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the specification in such a manner as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

We reverse this rejection.

#### DISCUSSION

##### 35 U.S.C. 112, first paragraph

Claims 14, 16 and 23-25 stand rejected under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the specification in such a saw as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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It is the examiner's position that "the newly amended claim to recite the weight percent of 20% to 30% and 25% to 30% does not find support in the instant specification." Answer, page 3. The examiner also argues that, "the new recitation wherein the weight percent is 20% to 30% in a hydrocarbon gel or mixture of hydrocarbon and petrolatum base and 25% to 30% in a petrolatum base does not find support in the instant specification." Id. For this reason the examiner argues that the claims recite new matter and do not find written descriptive support in the present specification.

In response, the appellants argue, "[t]he written description requirement does not require an applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.'" Brief, page 8, citing Union Oil of Cal. V. Atlantic Richfield Co., 208 F.3d 989, 997, 545 USPQ 1227, 1232 (Fed. Cir. 2000).

Appellants also argue that "[w]ith respect to amending numerical range limitations, such as in the present case, the Examiner's analysis is faulted, since the Examiner's analysis did not take into account which ranges one skilled in the art would consider are inherently or **implicitly** supported by the discussion in the original disclosure." Brief, page 8 (Emphasis original). Appellants also rely on the case law of In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), and In re Blaser, 556 F2d 534, 194 USPQ 122 (CCPA 1977). Brief, pages 8-9.

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We agree with appellants that the amended claim 14 before us contains subject matter which is described in the specification in such a manner as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Moreover, we do not find that the examiner's Answer addresses appellants' arguments as to the relevance of the Wertheim and Blaser patent law precedent to this case.

Whether a disclosure contains a sufficient written description is a question of fact. Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).

Our reviewing court has held in Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) that

[a] fairly uniform standard for determining compliance with the "written description" requirement has been maintained throughout: "Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). "[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

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The court also noted that

[t]he purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed.

Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1117.

We agree with appellants that both Wertheim and Blaser are controlling here for the reasons outlined in Appellants' Brief, pages 9-10. In particular, in Wertheim the specification recited a range of 25% to 60% by weight of coffee solids and exemplified processes using 36% and 50% solids. The Court of Claims and Patent appeals, the predecessor of our reviewing court, held that this disclosure supported a claim to 35% to 60% by weight of coffee solids, and that "persons skilled in the art would consider processes employing 35%-60% solids content to be part of appellants' invention ." In re Wertheim, 541 F.2d 257, 191 USPQ 90, (CCPA 1976). Likewise, in the present case, the specification describes that aspirin may be added to a base of comprising hydrocarbon gel and/or vaseline (petrolatum). Specification, page 3. In addition, the specification states that the amount of aspirin in the ointment "is 0.001 to 30% by weight, preferably 0.01 to 20% by weight, more preferably 0.05 to 15% by weight." Id. Example 4 in the specification provides an example of 25.0g of aspirin and 75.0g of hydrocarbon gel. Specification, page 6.

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In our view, the specification provides support for each point in the range of 0.001 to 30% of aspirin in the claimed ointment. Thus, the application relied upon reasonably conveys to the artisan that the inventor had possession of each composition with aspirin in the range of 0.001 to 30% both at the time the application was filed and at that time of the later claimed subject matter. See Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). We also note the amount of acetyl salicylic acid of 25%, as claimed, was exemplified both in the broad range indicated on page 3 of the specification and in example 4.

In view of the above, we do not find that the examiner has rebutted appellants' arguments with respect to implicit support in the specification for the questioned claim language in claim 14. Nor do we find that the claimed invention is of such a nature and level of unpredictability that the applicants' range of acetyl salicylic acid and amounts of hydrogel and petrolatum described in the specification has not conveyed with reasonable clarity to those skilled in the art that he or she was in possession of the invention as presently claimed.

#### CONCLUSION

The rejection of claims 14, 16 and 23-25 under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**REVERSED**

  
TONI R. SCHEINER  
Administrative Patent Judge

  
DONALD E. ADAMS  
Administrative Patent Judge

Demetra J. Mills  
DEMETRA J. MILLS  
Administrative Patent Judge

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